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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,986	02/10/2004	John F. Yanus	A3066-US-NP XERZ 2 01211	1319
63095 7590 04/07/2008 FAY SHARPE / XEROX - ROCHESTER 1100 SUPERIOR AVE. SUITE 700 CLEVELAND, OH 44114				
EXAMINER RODÉE, CHRISTOPHER D				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
04/07/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/775,986

**Applicant(s)**

YANUS ET AL.

**Examiner**

Christopher RoDee

**Art Unit**

1795

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6-16, 18, 20-27, 30, 31 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-16, 18, 20-27, 30 and 31 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 6-9, 14-16, 18, 20, 24, 25, 27, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura *et al.* in US Patent Application Publication 2002/0025483 in view of Otsuka *et al.* in US Patent 5,130,222.

Claims 10-13, 21-23, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura *et al.* in US Patent Application Publication 2002/0025483 in view of Otsuka *et al.* in US Patent 5,130,222 as applied to claims 1, 6-9, 14-16, 18, 20, 24, 25, 27, 30, and 31 above, in view of Yuh *et al.* in US Patent 6,261,729.

These rejections were presented in the last Office action. Applicants traverse the rejection because the supporting art only discloses a single charge transport layer and the primary reference fails to disclose or suggest two charge transport layers of equal thickness.

As noted previously, Kawamura discloses a photoconductive imaging member comprising, as seen in Figure 4, a conductive support **1**, a charge generating layer **5**, a first charge transport layer **4-1**, and a second charge transport layer **4-2** (¶¶ [0063], [0243], [0244], [0278], [0279]). Although the secondary references do not teach plural charge transport layers, the primary Kawamura reference does teach such an embodiment.

The art also reasonably suggests preparing layers of equal thickness. Kawamura's first charge transport layer has a thickness of from about 3 to about 50  $\mu\text{m}$  and the second charge transport layer has a thickness of from 0.15 to 10  $\mu\text{m}$  (¶¶ [0253] & [0279]). Applicants take the

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position that if the layers were considered by the artisan in whole micron thicknesses there would be 480 different combinations and very few of them would be of equal thickness. Further, applicants state that it would not be obvious to produce two charge transport layers of 10 micron thickness because the disclosed upper range limit of thicknesses for the second charge transport layer is not a specific disclosure at 10  $\mu\text{m}$  although the thickness range does vary from 0.15 to 10  $\mu\text{m}$ . Applicants cite the decision in *Atofina v. Great Lake Chem. Corp.*, in support of their position.

The Examiner has carefully considered applicants' remarks in light of the CAFC decision. The CAFC decision does not appear to be germane to the instant fact situation because the prior art question in *Atofina* was one of anticipation not obviousness. The CAFC did not analyze whether or not the upper limit of a range properly suggested that point within the legal conclusions involving obviousness. Rather, the CAFC addressed the overlapping range where various disclosures were combined from the reference in the factual determination of anticipation. The cited Court decision is not seen as relevant to the facts as presented in the applied rejections.

Although applicants are correct that there are a number of layer thickness combinations that are outside the scope of the claims, there are also a number of layer thickness combinations within the scope of the claims. As the Examiner noted in the last Office action, the reference suggests an end point at a 10 micron thickness as one effective thickness for a second charge transport layer. Other thicknesses are also suggested, such as those between 3 and 10 microns. The thicknesses between 3 and 10 microns for the first charge transport layer are also suggested by the references.

Although the combination of references can reasonably be said to suggest embodiments outside the scope of the claims, the references also lead to embodiments within the scope of

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the claims. That is all that is required under the standard of obviousness as set forth in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385. As noted in *KSR*, "it is error to apply TSM test as rigid and mandatory formula that limits obviousness analysis through formalistic conception of words 'teaching,' 'suggestion,' and 'motivation,' or by overemphasis on importance of published articles and explicit content of issued patents, since market demand, rather than scientific literature, often drives design trends, and granting patent protection to advances that would occur 'in the ordinary course' without real innovation retards progress and may, in case of patents combining previously known elements, deprive prior inventions of their value or utility." In the instant fact situation, the use of various layer thicknesses from disclosed falls within the scope of advances that would occur 'in the ordinary course' of research. The artisan would be reasonably able to predict the effects of various charge transport layer thicknesses and has ample reason to believe that all thicknesses disclosed would be effective for their intended purpose.

The rejections are maintained.

***Allowable Subject Matter***

Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 5:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/  
Primary Examiner  
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7 April 2008